

REMARKS/ARGUMENTS

Amendments and Status

Before this Amendment, claims 1-9, 12, 15-20, 23-31, 33-36, 41-50, 67, and 74-78 were present for examination. Claims 31 and 67 are amended to address certain objections and a §112 issue. No other claims are amended, added or canceled. Therefore, claims 1-9, 12, 15-20, 23-30, 33-36, 41-50, 67, and 74-78 are present for examination, and claims 1, 12, 23, 31, 35, 36, and 67 are the independent claims. No new matter is added by these amendments. Applicants respectfully request reconsideration of this application.

The Office Action dated November 8, 2006 ("Office Action") rejected claims 23, 24, 26, 28-30 and 35 under 35 U.S.C. §103(a) as unpatentable over the cited portions of Yen, U.S. 2002/0066789 A1 ("Yen") in view of the cited portions of Fujimoto, U.S. 2004/0080784 A1 ("Fujimoto"). The Office Action rejected claims 31, 33 and 34 under 35 U.S.C. §103(a) as unpatentable over the cited portions of Blank, U.S. Patent 7,032,817 ("Blank") in view of Fujimoto. The Office Action rejected claim 25 under 35 U.S.C. §103(a) as unpatentable over Yen as modified by Fujimoto and further in view of the cited portions of Duroj, U.S. 2002/0006103 A1 ("Duroj"). The Office Action rejected claims 1-9, 12, 15-20, 36, 41-50, 67 and 74-78 under 35 U.S.C. §103(a) as unpatentable over Yen as modified by Fujimoto and further in view of the cited portions of Biller, U.S. 2004/0182940 A1 ("Biller"). The Office Action rejected the remaining claims under 35 U.S.C. §103(a) as unpatentable over Yen and Fujimoto and further in view of other prior art. Moreover, the Office Action rejected claims 67 and 74-78 under 35 U.S.C. §112

35 U.S.C. §103(a) Rejections Blank/Yen and Fujimoto

The Office Action rejected independent claims 12, 23, 31, 35, and 36 under 35 U.S.C. §103(a) as unpatentable over Yen/Blank in view of Fujimoto (and in some instances other art). To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143. Applicants believe significant limitations from the claims are not found in the cited art.

Specifically, Fujimoto cannot be relied upon to teach "a live copy limit that is about 3/32 of an inch from" certain edges of the card, as generally recited in independent claims 12, 23, 31, 35, and 36. The Office Action concedes that neither Yen nor Blank teach this limitation (Office Action, p. 4, ll. 19-21; p. 8, ll. 18-20). Instead, the Office Action relies on Fujimoto to "teach a live copy limit that is within about 3/32 of an inch from the outside of the card" (*Id.*, p. 4, ll. 19-20; p. 5, ll. 1-8).

But the Office misstates the limitation found in the identified claims at issue. Although claim 1 recites a "live copy limit is within about 3/32 of an inch from an outside edge of the card" (emphasis added), the other claims are different. Independent claims 12, 23, 31, 35, and 36 recite a "live copy limit that is about 3/32 of an inch from" certain edges of the card (emphasis added). Being within about 3/32 of an inch from an outside edge is a different limitation than being about 3/32 of an inch from an outside edge.

The Office Action appears to equate the "safety margin" of Fujimoto with the copy limit of the claims (Office Action, p. 5, ll. 1-8, *citing* Fujimoto, ¶50; Figs. 12, 14, and 17). Applicants first contend that a copy limit differs from a "safety margin". Moreover, Fujimoto sets forth an example safety margin of .5 mm, and this is relied upon to teach the limitations of the claims. A .5 mm "safety margin" is .0197 inch, whereas 3/32 of an inch is .0938 inches. The copy limit set forth in the claims is approximately 5 times as large as the safety margin of Fujimoto. The "safety margin" of Fujimoto may not be relied upon to teach the specified copy limit of the claims.

Other limitations of the claims are also absent from the cited references:

Claim 12: Claim 12 provides that "the J-peg shaped aperture is located on one of the two side portions of the [3 3/8 inches x 2 1/8 inches] data card." The Office Action concedes that neither Yen nor Fujimoto can be relied upon to teach the limitation (Office Action, p. 9, l. 17 - p. 10, l. 19), instead relying upon Fig. 3 from Billar.

Claim 12 specifically sets forth a "J-peg shaped aperture ... located on one of the two side [2 1/8 inch] portions" of a rectangular data card. Nothing in Fig. 3 of Billar suggests

this configuration. Instead, a J-peg aperture is at the *rounded top* of a *non-rectangular* data card of different dimensions.

Claim 31: Claim 31 provides that "the diameter of the circular shaped portion is less than a longest length of the rectangular shaped bottom portion." The Office relies upon Fig. 4 of Blank to teach this limitation (Office Action, p. 8, ll. 13-14). But instead of teaching this limitation, the Fig. 4 of Blank seems at best to show a diameter that is the *same length* as the diameter of the bottom portion of the card, not less than the length of the rectangular shaped bottom portion, as claimed.

Claims 35 and 36: Claim 35 and 36 each recite a "rectangular shaped aperture" (emphasis added), and it is respectfully submitted that this limitation appears to be absent from Yen, Fujimoto, and Biller.

Applicants respectfully submit that independent claims 12, 23, 31, 35, and 36 are allowable for at least the foregoing reasons. Claims 15-20, 24-30, 33, 34, and 41-50 each depend from these independent claims, and are believed allowable for at least the same reasons as given above. Applicants respectfully request that the rejections to these claims under 35 U.S.C. §103(a) be withdrawn.

**35 U.S.C. §103(a) Rejection Yen, Fujimoto, Biller, and 35 U.S.C. §112 -
Independent Claims 1 & 67**

Claim 1: Claim 1 recites that "each aperture is at least about 1/16 of an inch from ... the live copy limit." Although it is not clear which portions of the cited references are being relied upon to teach this limitation, Applicants believe that the limitation is not found therein.

Fujimoto is relied upon by the Office to "teach a live copy limit " (Office Action, p. 4, ll. 19-20; p. 5, ll. 1-8). The Office relies on Biller to teach the two or more apertures recited in the claim. But nothing in the references teach the placement of the apertures relative to the live copy limit, as recited in the claim.

Claim 67: Claim 67 has been amended to recite "a top edge comprising two flat portions on either side of a protrusion portion." This amendment addresses the 35 U.S.C. §112 rejection.

The Office Action relies on Biller to teach this limitation (Office Action p. 10, ll. 12-19). But, the recited limitations (e.g., illustrated in FIGs. 10A-10I of the Original Application), are not shown by the Biller reference. None of the figures in Biller show "a top edge comprising two flat portions on either side of a protrusion portion ... [with] at least one aperture through the protrusion portion" as claimed.

Applicants respectfully submit that independent claims 1 and 67 are allowable for at least the foregoing reasons. Claims 2-9, 11, and 74-78 each depend from these independent claims, and are believed allowable for at least the same reasons as given above. Applicants respectfully request that the rejections to these claims under 35 U.S.C. §§103(a) and 112 be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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